

RECEIVED
CENTRAL FAX CENTER

AUG 25 2006

REMARKS

Claims 1-97 are currently pending, with claim 1 being the sole independent claim. Claims 1, 4, 28-31 and 73-84 have been amended. The amendments to claims 4 and 28-31 are to correct minor claim wording, and are cosmetic in nature. Support for the amendment to claim 1 may be found, for example, at pg. 2, 1st ¶ and at pg. 7, 2nd ¶ of the originally filed specification. No new matter has been added. Reconsideration of the application, as amended, is respectfully requested.

In the Office Action dated May 25, 2006, independent claim 1, and dependent claims 2-6, 8, 12-16, 18-22, 23-31, 43-45, 49-52, 56-59, 61, 65-69, 71, 72, 76-80, 82-84, 88-92, and 94-97 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,061,346 ("Nordman"), while dependent claims 7, 17, 32-36, 60, 70, 81 and 93 were rejected under 35 U.S.C. §103(a) as unpatentable over *Nordman* in view of RFC 2251 ("Wahl"). In addition, dependent claims 9-11, 37-39, 40-42, 46-48, 53-55, 60, 62-64, 73-75 and 85-87 were rejected under 35 U.S.C. §103(a) as unpatentable over *Nordman* in view of RFC 1771 ("Rekhter"). For the following reasons, it is respectfully submitted that all claims of the present application are patentable over the cited references.

Independent claim 1 has been amended to recite that the "first IP based network [is] a private computer based network comprising wireless capabilities that are implemented in a cellular communications terminal". Support for this amendment may be found, for example, at pg. 2, 1st ¶ and at pg. 7, 2nd ¶ of the originally filed specification, wherein the cellular communications system used in the claimed invention is described. No new matter has been added.

Nordman relates to a method and associated apparatus for accessing a private IP network with a wireless host by way of a wireless access network (see Abstract). *Nordman* (Abstract, lines 3-5) teaches once authenticated access is permitted to the private IP network, and the wireless host becomes a virtual host of the private IP network, a wireless host identifier is used to identify the wireless host. Thus, *Nordman* teaches remote accessing of a private network from a location using a wireless capability connected to an intermediary network. However, amended independent claim 1 is patentable over *Nordman* for at least two reasons.

BEST AVAILABLE COPY

Firstly, *Nordman* fails to teach that a "first IP based network [is] a private computer based network comprising wireless capabilities that are implemented in a cellular communications terminal," as recited in amended independent claim 1.

The Examiner (pg. 2, ¶2 of the Office Action) asserts *Nordman* teaches "a network element, said network element being arranged to act between a first IP based network and a second packet data network (GGSN 92 could be interpreted as a network as claimed and is arranged to act between home IP access control network 94, which could be interpreted as the first IP based network, and backbone network 46, which could be interpreted as the second packet data network. See Fig. 1-2 *Nordman*. . .). Thus, it is the Examiner position that the home IP access control network element reference part 94 of the HIPN disclosed in Fig. 1 of *Nordman* constitutes Applicant's claimed first IP network.

Nordman Fig. 1 shows additional home IP access networks HIPN 96, 102 and 106. *Nordman* (col. 5, lines 45, for example) clearly teaches that the home IP network is a private IP network. However, such HIPN networks (or private IP networks) fail to comprise wireless capabilities for a wireless communications terminal, as recited in amended independent claim 1.

Nordman teaches that the wireless host 21 must access a public GSM wireless access network (i.e. a GSM mobile terminal 16, GSM base station 52, base station controller 58, serving GPRS support node 82) and a backbone network 46 in order to permit connection of a wireless host 32 to the HIPN. Simply because the private network is required to connect to a public wireless network in order to connect to a cellular communications terminal does not mean that the private network itself possesses wireless capabilities. *Nordman* teaches nothing more than the private network is able to connect to a remote public network having wireless capabilities. Therefore, for at least this reason, independent claim 1 is patentable over *Nordman*.

Secondly, independent claim 1 is patentable because *Nordman* fails teach that a user within the home IP access control network, when communicating to a second user within the home IP access control network, connects only via the first IP network. A person having the ordinary level of skill in the art would achieve a system that is exactly opposite to what Applicant claims, based on the Examiner's asserted interpretation of the *Nordman* system. A user, for example, the remote communications station 12 communicating to a host within the

HIPN, must physically pass traffic data over the public networks of the second packet network, the backbone network, and the GSM network, since as discussed previously, the home IP access control network of *Nordman* fails to possess wireless capabilities of its own. Thus, *Nordman* teaches that any wireless communications terminal attempting to wirelessly connect to the HIPN via the GSM network element has the problem of requiring the terminal to access the public GSM network, even if the wireless communications terminal is physically located within the boundaries of the HIPN. As a result, the user has to pay network costs to the operator of the GSM network even if the communication is only to another user in the home IP access control network and the two are physically close.

In contrast, the claimed invention recited in amended independent claim 1 solves the problem of requiring a user to access a third party wireless access network by requiring the first private network to comprise wireless capability for a cellular communications terminal, and furthermore that any traffic intended for a user within the first IP network from another user within the first IP based network occurs without any signaling occurring externally of the first IP based network. *Nordman* fails to teach a system having these claimed features.

Nordman teaches a private IP network that is capable of being accessed via a wireless host as indicated by the Examiner. However, this access can only occur via a third party wireless access element. Moreover, as described by the Examiner (pg. 3 of the Office Action), the communications from the wireless device to the first IP network are required to tunnel via the second network, and thus any user connecting from the first network to another user in the first network must connect or tunnel via the second network, which is the exact opposite of what is recited in Applicant's amended claim 1, as discussed previously.

Furthermore, *Nordman* (Fig. 1) teaches that the user equipment must communicate via the backbone network (i.e., the second network) in order for the user equipment 12 to communicate with a user within the "boundaries" of the private IP access network, since even though a tunneling protocol is used, once authentication is successful, the backbone network is still required to physically carry the tunneled packets. Thus, even assuming *arguendo* that the tunnelling protocol is used once authentication has been successful, there is still a physical connection using the second IP network of *Nordman*. Furthermore, connections between any of

BEST AVAILABLE COPY

the home IP access control networks to a different home IP access control network occur via the backbone network and, therefore, in much the same manner the communications must occur physically by the second IP based network. Consequently, the communication are external to the first IP based network of the home IP access control network.

In contrast, amended independent claim 1 recites that "any traffic intended for a user within the first IP network from another user within the first IP based network occurs without any signaling occurring externally of the first IP based network". *Nordman* thus fails to teach independent claim 1. In view of the foregoing, independent claim 1 is patentable over *Nordman*, and therefore reconsideration and withdrawal of the rejection under 35 U.S.C. 102(b) are in order, and a notice to that effect is earnestly solicited.

The Examiner cites *Wahl* based on the failure of *Nordman* to teach the features cited in dependent claims 7 and 17. *Wahl* relates to directory access protocols that provides both read and write update access. However, *Wahl* fails to cure the deficiencies of *Nordman*, since *Wahl* fails to teach or suggest *inter alia* that "a private computer based network comprising wireless capabilities that are implemented in a cellular communications terminal," as recited in independent claim 1. Therefore, dependent claims 7 and 17 are also patentable over the combination of *Nordman* and *Wahl* due to their dependency on claim 1.

The Examiner cites *Rekhter* based on the failure of *Nordman* to teach the features cited in dependent claim 11. *Rekhter* relates to a Border Gateway Protocol (BGP). *Rekhter* (pg. 2, paragraph 2) teaches that BGP is an inter-Autonomous system routing protocol. However, *Rekhter* fails to cure the deficiency of *Nordman*, because *Rekhter* also fails to teach or suggest *inter alia* the claimed "private computer based network comprising wireless capabilities that are implemented in a cellular communications terminal," as recited in amended claim 1. Therefore, dependent claim 11 is also patentable over the combination of *Nordman* and *Rekhter* due to its dependency on independent claim 1. Consequently, the claimed invention is also patentable over the combination of *Nordman*, *Wahl* and/or *Rekhter* and thus, withdrawal of all the rejections under 35 U.S.C. §103(a) is in order, and a notice to that effect is requested.

In view of the patentability of amended independent claim 1, for the reasons set forth above, dependent claims 2-97 are all patentable over the prior art.

BEST AVAILABLE COPY

RECEIVED
CENTRAL FAX CENTER

020

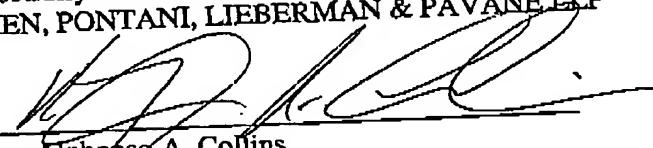
AUG 25 2006

Based on the foregoing amendments and remarks, this application is in condition for allowance. Early passage of this case to issue is requested.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE LLP

By



Alphonse A. Collins
Reg. No. 43,559
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: August 25, 2006

U.S. - AVAILABLE COPY